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IN THE

Supreme Court of the United States

October Term, 1960

No. 611

ALLEN B. DU MONT LABORATORIES, INC.,
Defendant-Appellee-Petitioner,

—v.—

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE (deceased),
Plaintiff-Appellant-Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

With Complete and Only Appendix in Court of Appeals and Additional Appendix in This Court

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December 29, 1960

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IN THE

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No. .....

ALLEN B. DU MONT LABORATORIES, INC.,

Defendant-Appellee-Petitioner,

—v.—

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, (deceased),

Plaintiff-Appellant-Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

Allen B. Du Mont Laboratories, Inc. (Defendant-Appellee below) petitions that a Writ of Certiorari issue to review a ruling made without opinion or order by the United States Court of Appeals for the Third Circuit on November 9, 1960 that a cause of action for patent infringement survives the death of the patent owner.

Opinions Below

The questions presented were twice briefed and twice argued before the Court of Appeals.

On Petitioner's motion to dismiss the appeal the questions presented were first briefed and argued. The motion was then dismissed on the ground the Court did have jurisdiction to entertain the appeal, and could dismiss the appeal only if it lacked jurisdiction to entertain it (17a, reported at 278 F. 2d 323, 3 Cir. 1960).

A motion for reconsideration was denied without opinion on June 23, 1960 (19a).

The same day, June 23, 1960, the Court in a letter from the Clerk to counsel (20a) proposed "to hear and decide first the right of the executrix to maintain the suit" on further briefs and argument if this met "with the approval of counsel." The letter stated that if the Court's decision should be adverse to Petitioner no order would be entered; and that in the event of such adverse decision the parties then would "brief and the Court will decide the issue raised by the appeal in respect to the validity and/or infringement of the patent (sic)" (21a).

Petitioner's counsel agreed to the procedure set forth by the Court of Appeals (22a) and the questions were again briefed and again argued before the Court on October 7, 1960 (24a). No opinion or order has been entered since this argument.

On November 9, 1960 the Clerk wrote a letter to counsel (25a) setting a schedule for briefs and argument "on the merits." Under the conditions stated in the Clerk's letter of June 23, 1960 (20a) the letter of November 9, 1960 clearly indicated that the Court had made a decision adverse to Petitioner.

On November 11, 1960 counsel for Petitioner requested the Court by letter (27a) to enter an order. This request was denied on November 21, 1960 in a letter from the Clerk (29a).

The opinion of Judge Layton (D. Del., 1957) granting Respondent's pre-trial motion to substitute the Executrix as plaintiff is reported at 154 F. Supp. 368 and printed at 7a-9a.

Petitioner's motion to dismiss at the trial, and Judge Layton's denial, are printed at 10a.

Jurisdiction

A. The Date of the Judgment (Ruling) Sought to Be Reviewed, and the Time of Its Entry.

The ruling of the Court of Appeals was announced by the Clerk's letter of November 9, 1960 (25a), in accordance with the Clerk's statement (21a) that no order would be entered if "the Court concludes that the executrix does have standing to maintain the suit."

B. Date of Order Respecting a Rehearing.

On November 11, 1960 Petitioner requested the Court to enter an order (27a), but this request was denied on November 21, 1960 by letter from the Clerk (29a).

C. Statutory Provisions Believed to Confer Jurisdiction on This Court.

28 U. S. C. 1254(1).

Questions Presented

1. Does a cause of action for patent infringement survive the death of the patent owner? The Courts below held that it does.

2. Does the District Court lose jurisdiction of an action for patent infringement on the death of the patent owner? The Courts below held that it does not.

3. May a District Court create a patent right never granted by Congress? The Courts below held that they had that power and, exercising that power, created the right of survival. The Courts below did not recognize that they were creating a patent right, or decide this question in the terms here presented. They simply held that the action survived.

Constitutional and Statutory Provisions Involved

A. Constitutional.

Article 1, Sec. 8. The Congress shall have power * * * To promote the progress of * * * useful arts, by securing for limited times to * * * inventors the exclusive right to their * * * discoveries.

B. Statutory.

There is no Federal statute which provides for the survival of a cause of action for patent infringement.

Statement of the Case

1. On July 14, 1954, George Washington Pierce sued Petitioner (1a, No. 1) for infringement of six patents listed at 3a.

2. Pierce died on August 25, 1956 (4a). Of the six patents in suit, five expired on October 18, 1955, nearly a year before Pierce's death. The sixth patent expired on December 16, 1958, before the trial, which started March 24, 1959 (1a, No. 7).

3. A Notice of Suggestion of Death of the original plaintiff (4a) and a Motion to substitute Helen Russell Pierce, Executrix, as plaintiff (5a) were filed on March 21, 1957. Petitioner opposed this motion, but it was granted by Judge Layton with an opinion (7a) which is reported at 154 F. Supp. 368 (D. Del. 1957).

4. A full trial was held before Judge Layton beginning March 24, 1959 (1a, No. 7). At the trial Petitioner made a motion to dismiss on the ground of lack of jurisdiction of the District Court due to the non-survival of the cause of action (10a). This motion was denied (10a).

5. Following the trial, all of the patents in suit, except patent No. 2,133,645, which was withdrawn at the opening of the trial (12a-13a, Nos. 6, 7; 14a; 16a), were held invalid in an opinion by Judge Layton filed on September 15, 1959 (11a), which is reported at 178 F. Supp. 84 (D. Del. 1959). Final Judgment to this effect was entered on December 15, 1959 (2a, No. 103). Judge Layton's opinion did not mention the survival question and is not printed herein for that reason (11a).

6. Respondent (Executrix) appealed (2a, No. 109). Petitioner brought a motion to dismiss the appeal on the ground that the Court of Appeals lacked jurisdiction because the cause of action did not survive the death of the original plaintiff. The question of non-survival was briefed and argued on the merits on April 19, 1960. The motion to dismiss was denied on May 9th, 1960, in an opinion (17a) reported at 278 F. 2d 323 (3 Cir. 1960), without consideration of the merits of the jurisdictional-survival question.

7. Petitioner brought a motion for reconsideration of its motion to dismiss the appeal. This was denied (19a), again without considering the merits of the jurisdictional-survival question. The Court of Appeals, however, by letter from the Clerk, ordered the jurisdictional-survival question to be presented first, and separately, if counsel agreed to this procedure (20a). The decision of the District Court holding all of the patents in suit invalid (except the one withdrawn) on the merits was not to be reviewed unless the Court of Appeals decided that it had jurisdiction because the cause of action survived (21a). Petitioner agreed to this procedure (22a).

8. On October 7, 1960, the second argument on the merits of the jurisdictional-survival question was heard by the Court of Appeals. The Court decided on November 9, 1960

that it did have jurisdiction over the cause of action, as a schedule was set (24a) for briefs and argument on the merits of the question of the validity of the patents. This, in accordance with the provisions of the Clerk's letter (21a), was to be done only if the Court decided that it did have jurisdiction. No opinion or order was entered by the Court of Appeals.

9. On November 11, 1960, Petitioner requested the Court of Appeals to enter an order stating its adverse decision on the merits of the jurisdictional-survival question, or a positive affirmation that it had so decided (27a). The Court of Appeals on November 21, 1960 refused to do this, by letter from the Clerk (29a).

10. There is no dispute between the parties as to the facts on the questions presented (12a, Nos. 1-5; 14a). The questions are ripe for decision by this Court.

Basis for Federal Jurisdiction in the Court of First Instance

This case arose under the United States Code, Title 35. The Court had jurisdiction under 28 U. S. C. 1338(a).

Reasons for Granting the Writ

1. The questions presented have never been decided in any reported decision above the District Court level.

2. Survival of an action for patent infringement has crept into the law and is becoming entrenched without guidance from any appellate Court.

3. This Court has made it emphatically clear that patent rights may be created only by statute. The decisions of the lower Courts violate this principle.

1. The Questions Presented Have Never Been Decided in Any Reported Decision Above the District Court Level.

For the first 166 years of the patent system, from 1789 to 1955, a cause of action for patent infringement did not survive the death of the patent owner. The question was not even raised, except in a single case in 1917 holding that it did not survive. The case was *Van Choate* v. *General Electric Co.*, 245 F. 120 (D. Mass. 1917).

Beginning in 1955 the District Courts have repeatedly granted survival. Judge Layton, in his opinion written in 1957, cited at 8a-9a seven such cases decided in the period 1955 to 1957, two of which are unreported.

No reported case has ever been decided above the District Court level.

2. Survival of an Action for Patent Infringement Has Crept Into the Law and Is Becoming Entrenched Without Guidance From Any Appellate Court.

In this case the Court of Appeals has not written an opinion, and has refused even to enter an order. This strange and incomprehensible reticence leaves the growing weight of District Court precedent unchecked. There is now strong precedent for survival in District Court cases, the unreported cases having been recorded in reported cases. This tide can be turned only by a higher Court.

The Court of Appeals has not even permitted its decision to be detectable as an unreported case. It can be ferreted out only from letters from the Clerk to counsel. This leaves the District Courts unrestrained to follow each other in compounding error.

3. This Court Has Made It Emphatically Clear That Patent Rights May Be Created Only by Statute. The Decisions of the Lower Courts Violate This Principle.

Following the *Van Choate* case in 1917 (245 F. 120, D. Mass. 1917) holding that a cause of action for patent infringement does not survive, this Court in 1922 decided the case of *Crown Die & Tool Co.* v. *Nye Tool & Machine Works*, 261 U. S. 24; 43 S. Ct. 254; 67 L. Ed. 516 (1922). It was held in that case that a cause of action for past infringement could not be assigned separately from an assignment of title to the patent. In deciding that question Mr. Chief Justice Taft at 261 U. S. 39 referred to the

> "• • • peculiar character of patent property and the recognized rules for the transfer of its ownership and its incidents. Patent property is the creature of statute law, and its incidents are equally so, and depend upon the construction to be given to the statutes creating it and them, in view of the policy of congress in their enactment."

The opinion continued:

> "It is not safe, therefore, in dealing with a transfer of rights under the patent law, to follow implicitly the rules governing the transfer of rights in a chose in action at common law."

The Chief Justice, speaking for a unanimous Court, then quoted with approval from the opinion of Mr. Chief Justice Taney, speaking for a unanimous Court in *Gayler* v. *Wilder*, 10 How. 477, 494, 13 L. ed. 504, 511 (1850), as follows:

> "The monopoly did not exist at common law, and the rights, therefore, which may be exercised under it, *cannot be regulated by the rules of the common law.* It is created by the act of congress; and *no rights can*

be acquired in it unless authorized by statute, and in the manner the statute prescribes." (Emphasis added.)

In numerous cases where Congress has created a statutory cause of action it has also, as is consistent with the general rule that survival is a creature of statute, expressly provided for survival of the cause of action. For example, survival is expressly provided for in:

1. Death or insanity of a bankrupt in bankruptcy proceedings: 52 Stat. 848 (1938), 11 U. S. C. §26 (1958), amending 30 Stat. 549 (1898).

2. Death or removal of the receiver or trustee in bankruptcy: 52 Stat. 860 (1938), 11 U. S. C. §74 (1958), amending 30 Stat. 557 (1898).

3. Death of the Contestant of a Homestead claim: 60 Stat. 1100 (1946), 43 U. S. C. §185 (1958), amending 21 Stat. 141 (1880).

4. Death of an entryman in a homestead claim prior to the expiration of the 3 years habitation necessary for the grant of a patent: R. S. §2291 (1912), 43 U. S. C. §164 (1958).

5. Death of the defendant in a civil action for damages, commenced by or on behalf of the United States: 28 U. S. C. §2404 (1958).

6. Death of a railroad employee for injuries sustained: 36 Stat. 291 (1910), 45 U. S. C. §59 (1958).

7. Actions by and against certain dissolved government corporations (allowed survivorship to and against the Reconstruction Finance Corporation if motion for survival was made within 12 months after the corporation was dissolved): ch. 215, §2, 59 Stat. 310 (1945). (Reconstruction Finance Corp. abolished by §6(a) of 1957 Reorganization Plan No. 1, 22 F.R.

4633, 71 Stat. ——; see note at 15 U. S. C. §611 (1958).)

8. When an officer or head of any department or agency of the National Military Establishment is transferred or his title is changed, suits, actions, or proceedings by or against him survive: 61 Stat. 508 (1947), 5 U. S. C. §1711(b) (1958).

9. Cause of action for recovery for injury to or death of a seaman: 41 Stat. 1007 (1920), 46 U. S. C. §688 (1958).

10. Compensation for injury to a longshoreman or harbor worker even in the event of death arising from causes other than the injury: 70 Stat. 655 (1956), 33 U. S. C. §908(d) (1958).

11. Compensation for injury causing death of a longshoreman or harbor worker: 70 Stat. 655 (1956), 33 U. S. C. §909 (1958). See also 44 Stat. 1426 (1927), 33 U. S. C. §905 (1958).

12. Suits by or against the Regional Agricultural Credit Corporation of Washington D. C. are not to abate on transfer of functions: Ch. 49, §3(a), 63 Stat. 44 (1949). (Omitted when 12 U. S. C. §1148a-3 (1958) was executed.)

13. Surviving widow, child or parent of a veteran who died as a result of an injury or disease incurred in or aggravated by armed service is entitled to compensation: Wartime, 38 U. S. C. §321 (1958). Peacetime, 38 U. S. C. §341 (1958).

Even in the Patent Act itself, in the first paragraph of 35 U. S. C. 252, Congress provided for non-abatement of a cause of action then existing on surrender of an original patent upon the issue of a reissue, "in so far as the claims of the original and reissued patents are identical."

The above statutes clearly show that Congress has been just as alert in providing for survival, where survival was intended, as have been the various states in passing their respective survival statutes. Since there is no statute providing for survival, it is clearly the intent of Congress that actions for patent infringement shall not survive. As was said by Judge Learned Hand in *Cheney Bros.* v. *Doris Silk Corporation*, 35 F. 2d 279 (2d Cir. 1929) at page 281:

> "Judges have only a limited power to amend the law; when the subject has been confided to a Legislature, they must stand aside, even though there be an hiatus in completed justice. An omission in such cases must be taken to have been as deliberate as though it were express, certainly after long-standing action on the subject matter."

And in the case of *United States* v. *American Bell Telephone Co.*, 167 U. S. 224, at page 247; 42 L. Ed. 144 (1897) this Court said at pages 156-7.

> "A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural, but of purely statutory, right. Congress, instead of fixing seventeen, had the power to fix thirty, years as the life of a patent. *No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public.*" (Emphasis added.)

Nor can any Court give a statutory right which can be created only by Congress. To do so would be a complete circumvention of the Constitution and a usurpation of the powers of Congress.

Prior to the enactment of the statute referred to in No. 6, at page 9 above, providing for survival of a cause of action

for death of a railroad employee, the Court in *Flugham* v. *Midland Valley R. Co.*, 167 Fed. 660 (W. D. Ark., Ft. Smith Div. 1909) said at page 664:

> "but it will be seen that the statute of Arkansas did precisely what the statute under consideration did not do —it provided expressly for the survival of the action, and vested the right of action in the personal representative in the event the injured person died. It cannot be that legislation so much discussed in and out of Congress, and which had to be so carefully mature and drawn in order to meet the views of the courts, legislation, too, which inherently shows the skill of the lawyer evidently familiar with the settled principles of the common law which it modifies in the interest of justice and humanity, is not expressive of the will of Congress, or omits anything which Congress intended to do by it. It would have been so easy for Congress to have said, as the legislation of so many states had previously provided, that in the event the employe injured should die from the injury his cause of action should survive to his personal representative, that it can scarcely be conceived that the provision would have been omitted had Congress so intended. *But whatever Congress may have intended, it has not done so, and the courts must confine themselves to the administration of the law, and neither add nor take from a statute where its language is clear and unambiguous.* In the opinion of the court the right of action given to the injured employe by the act of April 22, 1908, does not survive to his personal representative in the event of his death but as at common law, perishes with the injured person." (Emphasis added.)

Since the *Van Choate* case in 1917, which expressly held against survival of a cause of action for past infringement, and the *Crown Die* case in 1922, emphasizing that patent

rights may be created only by Congress, the patent laws have been codified twice, with considerable revision on each occasion. In each new patent statute the law, as expressed in these two cases, has been allowed to stand by Congress. Therefore, everything that is said in *Flugham* v. *Midland Valley R. Co.* is equally applicable to the patent laws. Only Congress can change the law—if it is to be changed at all.

There is no doubt that the question of whether a cause of action survives the death of a party goes to jurisdiction.

Snyder v. *Buck*, 340 U. S. 15, 20-22; 95 L. Ed. 15 (1950);

Irving Klaw v. *Robert H. Schaffer*, 357 U. S. 346; 2 L. Ed. 2d 1368 (1958);

William Glanzman v. *Robert H. Schaffer*, 357 U. S. 347; 2 L. Ed. 2d 1368 (1958).

CONCLUSION

For the foregoing reasons it is respectfully urged that this petition be granted.

Respectfully submitted,

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New York, N. Y.
December 23, 1960

COMPLETE AND ONLY APPENDIX IN COURT OF APPEALS

Relevant Docket Entries

1.	July 14, 1954	Complaint: summons issued. (Exit papers to Marshal)
18.	Mar. 21, 1957	Suggestion of death of pltf.
19.	Mar. 21, 1957	Motion for substitution of pltf. Helen Russell Pierce.
20.	May 9, 1957	Brief of pltf. in support of motion for substitution.
21.	May 9, 1957	Brief of deft. opposing substitution of executrix.
22.	May 22,	Reply brief of pltf. in support of motion for substitution of pltf.
H.	May 28, 1957	Hearing, Layton J., on motion of pltf. to substitute Helen Russell Pierce as pltf.
25.	June 21, 1957	Opinion, Layton J., on motion of pltf. to substitute Helen Russell Pierce as pltf. (Notice to counsel)
26.	June 26, 1957	Order, Layton J., substituting as pltf. Helen Russell Pierce, Executrix of Last Will and Testament of George Washington Pierce.
T.	Mar. 24, 1959	Trial to the Court, Mar. 24, 25, 26, 31, Apr. 1, 2, 3, 6, 7, 8, 9, 10, 13 59 (Layton J.)
81.	Apr. 16, 1959	Transcript of trial in 4 volumes.
82.	June 1, 1959	Brief of deft.
93.	Sept. 25, 1959	Motion of deft. for additional findings of fact.

Relevant Docket Entries

96.	Oct. 9, 1959	Motion of pltf. for additional findings of fact.
102.	Dec. 7, 1959	Comment of deft. in opposition to pltfs. proposed additional findings of fact.
103.	Dec. 15, 1959	Final judgment holding certain patents valid and others invalid and dismissing as to certain patents enjoining pltf. from institution suit as to certain patents, and denying defts. motion for attorney's fees for defense of entire case and reserving questions re defts. motion for attorneys fees a/c withdrawal by pltf. of Pierce Patent 2,133,645 just prior to trial until after time for appeal has expired.
105.	Dec. 17, 1959	Motion of deft. for additional findings of fact.
106.	Dec. 22, 1959	Motion of pltf. for additional findings of fact.
107.	Jan. 27, 1960	Memorandum Opinion, Layton J., on motions of both parties for additional findings.
108.	Feb. 17, 1960	Order, Layton J., on motions of pltf. and deft. for additional findings of fact granting pltfs. proposed findings Nos. 1-5 and denying Nos. 6-13 and 15 and granting in part No. 14 and granting defts. motion for proposed findings 1 to 7. (Notice to counsel)
109.	Mar. 16, 1960	Notice of appeal of pltf.

Statement re Complaint

The complaint is for infringement of six patents. Only the prayer for relief is reproduced here. The six patents are:

Pierce	2,133,642,	issued	October 18, 1938
"	2,133,643,	"	"
"	2,133,645,	"	"
"	2,133,646,	"	"
"	2,133,648,	"	"
"	2,266,070,	"	December 16, 1941.

Prayer for Relief in Complaint

Wherefore the plaintiff demands preliminary and final injunctions against further infringement by the defendant and those controlled by the defendant; an accounting of profits and damages, an assessment of costs against the defendant, attorney's fees and, in view of the wanton character of the said infringement, such additional amount, not exceeding, in all, three times the amount of actual damages, as the Court may adjudge, and such other and further relief as may be just.

Suggestion of Death

To: Edward G. Pollard, Esq.
Clerk, U. S. District Court
Federal Building
Wilmington, Delaware

The plaintiff in this action, George Washington Pierce, died on August 25, 1956, and his death is hereby suggested of record.

March 21, 1957

THOMAS COOCH
Attorney for Plaintiff

CONNOLLY, COOCH & BOVE
Beneficial Building
Wilmington 1, Delaware

Motion for Substitution of Plaintiff

Suggestion of the death on August 25, 1956 or George Washington Pierce, plaintiff in this action, having been filed with the Clerk of this Court, and the certificate of Hon. John J. Foley, Register of the Probate Court for the County of Middlesex and State of Massachusetts, certifying the appointment by said Probate Court of Helen Russell Pierce as the Executrix of the Last Will and Testament of said George Washington Pierce, deceased, being attached hereto and filed herewith, motion is hereby made for an order of this Court that said Helen Russell Pierce, Executrix, be substituted for George Washington Pierce, deceased, as party plaintiff.

March 21, 1957

THOMAS COOCH
Attorney for Helen Russell Pierce, Executrix of the Last Will and Testament of George Washington Pierce, Deceased

CONNOLLY, COOCH & BOVE
Beneficial Building
Wilmington 1, Delaware

Certificate Certifying Appointment

No. 338218

COMMONWEALTH OF MASSACHUSETTS.

MIDDLESEX, *ss.* PROBATE COURT.

I, JOHN J. FOLEY, Register of the Probate Court for said County of Middlesex, hereby certify, that at a Probate Court holden in and for said County on the sixteenth day of October in the year of our Lord one thousand nine hundred and fifty-six the last will and testament of George Washington Pierce late of Cambridge in said County, deceased testate, was duly proved and allowed in accordance with the laws of said Commonwealth, and letters testamentary thereon issued to Helen Russell Pierce of Cambridge in the County of Middlesex, the executrix therein named who gave bond to the acceptance of the Judge of said Court for the due performance of said trust according to law.

I ALSO CERTIFY, that it appears by the records and files of said Court, that said letters are now in full force.

IN WITNESS WHEREOF, I have hereunto set my hand and affixed the seal of said Court, this seventh day of November in the year of our Lord one thousand nine hundred and fifty-six.

JOHN J. FOLEY
Register

BAB

Opinion by Layton, *District Judge*

154 F. Supp. 368

GEORGE WASHINGTON PIERCE,

Plaintiff,

—v.—

ALLEN B. DU MONT LABORATORIES, INC.,

Defendant.

Civ. A. No. 1624

United States District Court
D. Delaware.

June 21, 1957.

Thomas Cooch (of Connolly, Cooch & Bove), Wilmington, Del., for Helen Russell Pierce, executrix of the last will and testament of George Washington Pierce, Deceased. David Rines and Robert H. Rines (of Rines and Rines), Boston, Mass., of counsel.

Richard F. Corroon (of Berl, Potter & Anderson), Wilmington, Del., for defendant. Floyd H. Crews and Donald J. Overocker (of Darby & Darby), New York City, of counsel.

LAYTON, *District Judge.*

Motion for substitution of party plaintiff.
Granted.

Plaintiff-inventor died August 25, 1956. On March 21, 1957, suggestion of death was made and pursuant to Rule 25(a) F.R.Civ.P., 28 U.S.C., plaintiff's widow-executrix

moved that she be substituted as a party plaintiff. Defendant opposes the motion as to five of the six patents involved, upon the three following grounds: (1) The action is for a tort, (2) to recover a penalty, and (3) to recover for past infringement, all of which, it is argued, were extinguished by plaintiff's death. As to the sixth patent, it is admitted that the executrix is entitled to maintain a suit for injunctive relief and for damages caused by infringement during her ownership.

Defendant presses its opposition in the face of Armstrong v. Emerson Radio & Phonograph Corp., D.C.S.D.N.Y. 1955, 132 F.Supp. 176, and Armstrong v. Allen B. Du Mont Laboratories, D.C.D.Del. 1955, 137 F.Supp. 659.[1] Not only is the Emerson case squarely opposed to defendant's contentions but the Du Mont case, which cites it with complete approval, is a precedent from this district. And, while not absolutely binding upon me as the law of the case, T. C. F. Film Corp. v. Gourley, 3 Cir., 240 F.2d. 711, the soundest reasons of judicial comity dictate that neither case, particularly the Du Mont case, should be overruled by me here. Dow v. Carnegie-Illinois Steel Corp., D.C.W.D.Pa., 108 F.Supp. 88.

Defendant relies heavily on Van Choate v. General Electric Co., D.C.D.Mass. 1917, 245 F. 120. This decision reaches a directly opposite result from the Emerson and Du Mont cases and for many years represented the sole authority on the questions here presented. Moreover, in 1922, it received powerful, if indirect, support from certain language of Chief Justice Taft in Crown Die & Tool Co. v. Nye Tool & Machine Works, 261 U.S. 24, 43 S.Ct. 254, 67 L.Ed. 516. Nevertheless, in 1955, the Van Choate decision was impliedly overruled by Armstrong v. Sylvania, D.C.D. Mass. 1955, Civ.No. 54-6-S, and, in addition to Armstrong v. Emer-

[1] Both cases are based upon the identical facts as the case at bar.

son and Armstrong v. Du Mont, elsewhere cited, a number of Courts have recently permitted substitution in cases similar to this. Pierce v. Int. Tel. & Tel. Corp., D.C.N.J.1956, 147 F.Supp. 934; Pierce v. American Communications Co., Inc., D.C.D.Mass. Unreported 1957, C.A. No. 51-526; Pierce v. Mackay Radio and Tel. Co., Inc., D.C.D.Mass. 1957, 154 F.Supp. 157; Pierce v. Aeronautical Communications Equip., Inc., D.C.D.Fla. Unreported 1957, C.A. No. 5638M.

Though the Van Choate case, coupled with the incidental comments of the Supreme Court in the Crown Die and Tool Co. case, make a persuasive argument for a contrary result, I am not prepared to state categorically that the Emerson and Du Mont cases are wrongly decided. Indeed, the whole trend of modern authority is with them.

For the reasons stated, no detailed analysis of defendant's arguments need be made.

Motion granted.

Trial Transcript Page 1152

Mr. Crews: Your Honor, I move to dismiss the complaint on the ground that the Court does not have jurisdiction and more specifically that the cause of action did not survive the death of the original plaintiff, Professor Pierce. Your Honor has already ruled on that.

The Court: You are simply making your record.

Mr. Crews (sic): I understand, and, having ruled on it, I will at this stage deny the motion.

Statement re Opinion of Judge Layton After Trial

(178 F.Supp. 84, D.Del. 1959)

Judge Layton's opinion on the merits is reported at 178 F. Supp. 84. It is summarized in our brief at page 2, No. 5. It is not reproduced here because it contains no mention of the question of survival of the cause of action, the only question presented at this time.

Motion for Additional Findings of Fact

Pursuant to Rule 52(b), defendant moves the Court to amend its findings of fact and conclusions of law, heretofore filed in its decision entered December 15, 1959, by making the following additional findings of fact:

1. That the original plaintiff in this action was George Washington Pierce, and that said Pierce died on August 25, 1956, while the action was pending.

2. The widow of George Washington Pierce was appointed Executrix of his estate and on a motion under Rule 25(a) F.R.C.P., the Executrix was substituted as the party plaintiff in this action.

3. Defendant opposed the motion to substitute the present plaintiff (Executrix of the Estate of George Washington Pierce) on the ground that the cause of action did not survive, but was extinguished with the death of the original plaintiff, George Washington Pierce.

4. Substitution of the present plaintiff was permitted by Judge Layton as stated in an opinion reported at 154 F. Supp. 368 (D.Del.1957) on the ground that the cause of action did survive.

5. Defendant's motion to dismiss the complaint, made at the trial of this action, on the ground that the cause of action did not survive was denied (Tr. 1152).

6. At the trial, plaintiff's attorney made an opening statement (Tr. 5). Thereafter defendant's attorney made an opening statement (Tr. 6). Thereupon, plaintiff's attorney made a supplemental opening statement. At the

close of plaintiff's supplemental opening statement, Patent No. 2,133,645, in its entirety, was withdrawn from this action (Tr. 10).

7. During plaintiff's supplemental opening statement, after Patent No. 2,133,645 was withdrawn from suit, plaintiff stated (Tr. 10) that the judgment which was to be entered in this action may include suitable provisions that plaintiff would be enjoined from hereafter suing defendant, or its customers, or any parties in privity with defendant, on any and all claims of the aforesaid patent for the manufacture, use or sale of apparatus which is alleged to infringe.

BERL POTTER & ANDERSON
By RICHARD F. CORROON
350 Delaware Trust Building
Wilmington, Delaware

Attorneys for Defendant

Memorandum Opinion by Layton, *District Judge*

IN THE

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

Civil Action No. 1624

HELEN RUSSELL PIERCE, Executrix of the Estate of George Washington Pierce, Deceased,

Plaintiff,

—v.—

ALLEN B. DU MONT LABORATORIES, INC.,

Defendant.

Thomas Cooch (of Connolly, Cooch & Bove), Wilmington, Del., for plaintiff. David Rines and Robert H. Rines (of Rines and Rines), Boston, Mass. Of Counsel.

Richard F. Corroon (of Berl, Potter & Anderson), Wilmington, Del., for defendant. Floyd H. Crews and Donald J. Overocker (of Darby & Darby), New York City. Of Counsel.

LAYTON, *District Judge*:

Plaintiff's and defendant's additional requested findings #1-#5 are granted. Plaintiff's requested additional findings #6 and #7 are denied and defendant's additional requested findings #6 and #7 are granted.

Plaintiff's additional requested finding #8 is denied on the grounds of lack of relevancy.

Plaintiff's additional requested findings #9, #10, #11, #12 and #13 are denied because they do not state the situation with complete accuracy. For several years, Mr. Rines did not comply with the position taken by the Ex-

aminer to the effect that there should be a division. Rather he kept submitting proposed amendments which the Examiner would not accept. However, Mr. Rines never actually refused to comply and at no time did the Examiner actually order a division. Finally, on July 21, 1957, the Examiner wrote a detailed response to certain amendments submitted by Rines in January, 1927, and concluded with this paragraph:

> "There are far too many claims in the case for the subject-matter involved. Since considerable time has been spent by Examiner in attempting to make a detailed action on the merits of the case, a full and detailed response, with a showing of how each and every claim retained in the case is patentable over the holdings herein, and over each other claims, will be strictly required. Furthermore, since the manner of prosecution of this case has not been such as to reasonably advance the case, now over three years old, it will be necessary to close it before the Primary Examiner in the near future, and let applicant seek his remedies elsewhere."

Rines, seeing that he would either have to divide or suffer a final rejection by the Examiner and appeal therefrom, voluntarily divided.

Plaintiff's additional requested finding #14 is granted to the following extent: It seems to have been the practice of some patent attorneys to make a written notation of their understanding of what transpired in oral interviews between them and the Examiner.

Plaintiff's additional requested finding #15 is denied because not supported by the record.

At Wilmington,
January 27, 1960.

Order on Motions for Additional Findings of Fact

AND NOW, to-wit this 17th day of February 1960, both parties having moved for additional findings of fact under Rule 52(b) F.R.C.P., the matter having been fully briefed and argued before the court, and the court, after due consideration, having filed a memorandum opinion dated January 27, 1960, it is, for the reasons set forth in said memorandum opinion, ORDERED:

1. Plaintiff's motion for additional findings is granted as to her proposed findings Nos. 1-5, and denied as to Nos. 6-13 and 15.

2. Plaintiff's motion as to her proposed finding No. 14 is granted to the extent that the following additional finding is hereby made:

"It seems to have been the practice of some patent-attorneys to make a written notation of their understanding of what transpired in oral interviews between them and the Examiner."

3. Defendant's motion for its additional proposed findings Nos. 1-7 is granted.

4. Pursuant to Rule 73(a) F.R.C.P. the time for appeal from the final judgment entered herein on December 15, 1959 will commence to run with the entry of this order.

CALEB R. LAYTON 3RD
United States District Judge

Approved as to form:

THOMAS COOCH
Attorney for Plaintiff

RICHARD F. CORROON
Attorney for Defendant

Per Curiam Opinion of Court of Appeals

278 F. 2d 323

COURT OF APPEALS

THIRD CIRCUIT

PIERCE

—v.—

ALLEN B. DU MONT LABORATORIES, INC.

Decided May 9, 1960

THOMAS COOCH, Wilmington, Del., for plaintiff.

FLOYD H. CREWS, New York, N. Y. for defendant.

Before BIGGS, *Chief Judge*, and MCLAUGHLIN and HASTIE, Circuit Judges.

PER CURIAM.

Du Mont has moved to docket and dismiss the appeal at bar, that of Pierce, Executrix. The basis asserted for dismissal is the death of the original plaintiff, G. W. Pierce. The suit involves the validity and infringement of certain patents formerly owned by him and now possessed by his Executrix. Du Mont asserts that since, allegedly, the cause of action did not survive G. W. Pierce's death the suit should have been dismissed by the court below since his Executrix does not have the standing to maintain it. The court below ruled against Du Mont on this issue and determined the case on the merits rendering judgment against

the Executrix. Pierce v. Allen B. Du Mont Laboratories, Inc., 178 F. Supp. 84, 123 USPQ 305 (1959).

[1] Du Mont's motion must be denied. We can dismiss an appeal only if we lack jurisdiction to entertain it. Here, clearly we have jurisdiction to decide whether the court below was right or wrong in holding (1) that the Executrix had the right to maintain the suit, and (2) whether the court below was right or wrong in holding on the merits that the patents sued on were invalid and not infringed. Consequently the motion to dismiss must be denied. An order to that effect will be entered.

Order of Court of Appeals

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT

No. 13279

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of George Washington Pierce, Deceased,

Appellant,

—vs.—

ALLEN B. DU MONT LABORATORIES, INC.

Present:

BIGGS, *Chief Judge*, and
MCLAUGHLIN and HASTIE, *Circuit Judges*.

Upon consideration of the motion of defendant-appellee for reconsideration of its motion to dismiss the appeal in the above entitled case,

It is ORDERED that the motion be and it hereby is denied.

By the Court,

BIGGS, *Chief Judge*

Dated June 23, 1960

Letter Dated June 23, 1960

OFFICE OF THE CLERK
UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT
2046 U. S. COURTHOUSE
PHILADELPHIA 7

IDA O. CRESKOFF
CLERK

TELEPHONE
WA. 2-3144

June 23, 1960

Thomas Cooch, Esq.,
Beneficial Building
Wilmington, Delaware

Robert H. Rines, Esq.
10 Post Office Square
Boston 9, Mass.

Floyd Crews, Esq.
405 Lexington Ave.
New York 17, N. Y.

Richard F. Corroon, Esq.
Delaware Trust Building
Wilmington, Delaware

Pierce, Executrix, etc.,
appellant

vs.

Allen B. Du Mont Laboratories Inc.,

No. 13279

Dear Sirs:

Enclosed is a copy of an order entered today in the above entitled case.

The Court proposes to hear and decide first the right of the executrix to maintain the suit. The briefs and appendices should therefore be restricted to this sole issue. If the Court concludes that the executrix has no standing to maintain the suit, that will end the litigation in this Court.

Letter Dated June 23, 1960

If, on the other hand, the Court concludes that the executrix does have standing to maintain the suit, the Court will not enter an order upon that opinion, and the parties will brief and the Court will decide the issue raised by the appeal in respect to the validity and/or infringement of the patent.

If the foregoing meets with the approval of counsel and they will so state in a letter to the Clerk, the Court will proceed as indicated.

Very truly yours,

/s/ IDA O. CRESKOFF
Clerk

sw
enc:

ADDITIONAL APPENDIX IN THIS COURT

Letter Dated June 28, 1960

DARBY & DARBY
CHRYSLER BUILDING
405 Lexington Avenue
New York 17, N. Y.

June 28, 1960

Mrs. Ida O. Creskoff
Clerk, United States Court of
Appeals for the Third Circuit
United States Court House
Philadelphia, Pennsylvania

Re: Pierce v. Du Mont,
Appeal No. 13,279

Dear Mrs. Creskoff:

Thank you for your letters of June 23 and 24. I have been out of town since the 23d which accounts for my delay in answering.

I enclose my Notice of Appearance.

The procedure outlined in your letter to counsel of June 23d meets with my approval. I have agreed with Mr. Cooch that at this preliminary hearing I carry the burden and will file the first brief and appendix. We hope to have our brief and appendix on file within a week.

We will proceed accordingly unless you advise us of some different procedure, particularly one of those suggested in the following paragraphs.

I am authorized by Mr. Cooch to say that we are in agreement that my motion papers already on file in the Court correctly state all of the facts that there are on the issue

Letter Dated June 28, 1960

of the right of the Executrix to maintain the suit; that we are willing to stipulate that the motion papers on file may be accepted as the appendix on this issue; that the briefs on file may be accepted as the briefs on this issue; and that the issue may be considered to be submitted, and may be decided without further oral argument.

If the Court desires I will be glad to print our brief which has already been submitted, with a printed appendix consisting of the motion papers already submitted, and also to print Mr. Cooch's answering brief and our reply brief. This could all be done within a week after I get word from you, so that within two weeks from now the question could be submitted for decision on the printed documents.

In the alternative I would be willing to print all three briefs with a new appendix consisting of copies of the appropriate official documents, so that the matter could be promptly submitted for decision on these printed documents, without further oral argument.

I am not in any sense trying to resist the procedure suggested by the Court but am simply suggesting procedure which I hope will be simpler, more expeditious, and equally satisfactory to the Court.

Respectfully,

/s/ Floyd H. Crews
Floyd H. Crews
Attorney for Defendant-Appellee

mc
cc: Thomas Cooch, Esq.

Statement Regarding Second Hearing Before the Court of Appeals

Following the procedure outlined in the Clerk's letter (20-21a), the questions here presented were briefed and argued before the Court of Appeals for the second time on October 7, 1960.

No opinion or order has been entered, but the next paper, setting a schedule for briefs and argument on the "merits", follows the procedure Mrs. Creskoff stated (21a) would follow a decision "that the executrix does have standing to maintain the suit."

Letter Dated November 9, 1960

OFFICE OF THE CLERK
UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT
2046 U. S. COURTHOUSE
PHILADELPHIA 7

IDA O. CRESKOFF
CLERK

TELEPHONE
WA. 2-3144

November 9, 1960

Thomas Cooch, Esq.
120 Montvale Road
Weston 93, Mass.

Floyd Crews, Esq.
Darby & Darby
405 Lexington Avenue
New York 17, N. Y.

Pierce, Exec., etc., appellant vs.
Allen B. Du Mont Laboratories, Inc.
No. 13279

Dear Sirs:

Argument on the merits of the appeal in the above entitled case is listed for Monday, February 6, 1961, at 10:30 A.M.

Letter Dated November 9, 1960

Schedule for the briefs is as follows:

December 10, 1960—Appellant's brief and appendix

January 9, 1961—Appellee's brief and appendix, if any.

January 24, 1961—Appellant's reply brief.

Please acknowledge receipt of this notice.

Very truly yours,

IDA O. CRESKOFF
Clerk

sw
cc:

Robert H. Rines, Esq.
Berl Potter & Anderson, Esqs.
Connolly, Bove and Lodge, Esqs.

Letter Dated November 11, 1960

DARBY & DARBY
CHRYSLER BUILDING
405 Lexington Avenue
New York 17, N. Y.

November 11, 1960

Hon. John Biggs, Jr., Chief Judge
Hon. William H. Hastie, Judge
Hon. Phillip Forman, Judge
United States Court of Appeals
for the Third Circuit
United States Court House,
Philadelphia 7, Pa.

Re: Pierce, Executrix v. Allen
B. Du Mont Laboratories, Inc.,
Appeal No. 13279

Gentlemen:

For your information, I enclose a copy of a letter addressed to the Counsel in this case by Mrs. Creskoff, dated June 23, 1960.

Since that letter was written the question of the right of the Executrix to maintain this suit has been briefed and was argued before the Court on October 7, 1960.

I am now in receipt of a copy of a letter addressed to Counsel by Mrs. Creskoff, dated November 9, 1960, setting the schedule for arguments on the merits before the Court. I assume that, as indicated in Mrs. Creskoff's letter of June 23, 1960, this means the Court has concluded that the Executrix does have standing to maintain the suit.

In response to the last paragraph of Mrs. Creskoff's letter of June 23, 1960, I wrote her approving the proce-

dure set forth in her letter. This procedure included the omission of the entry of an Order at this time.

Despite my approval of that procedure, I request that the Court at this time enter an appropriate Order, or at least inform me positively that the Court has at this time concluded that the Executrix does have standing to maintain the suit. My reason for this request is that I wish to file a petition to the Supreme Court at this time for a writ of certiorari to review the question. If the Supreme Court will review the question now and should decide that the Executrix does not have standing, this will save the large expense incident to a review of the merits of the patents by this Court, and a great deal of this Court's time.

A copy of this letter is being sent to Mr. Thomas Cooch, Attorney for the Executrix.

Respectfully,

/s/ Floyd H. Crews
Floyd H. Crews

mc
Encl.

cc: (with copy of Enclosure)
Thomas Cooch, Esq.
120 Montvale Road
Weston 23, Massachusetts

Letter Dated November 21, 1960

OFFICE OF THE CLERK

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT
2046 U. S. COURTHOUSE
PHILADELPHIA 7

IDA O. CRESKOFF
CLERK

TELEPHONE
WA. 2-3144

November 21, 1960

Richard F. Corroon, Esq.
Berl Potter & Anderson
Delaware Trust Building
Wilmington, Delaware

Pierce, etc. vs. Allen B. DuMont Laboratories, Inc., No. 13279

Dear Sir:

The Court desires me to inform you that it does not see fit to enter any further order at this time in this case and that counsel are to be prepared to argue and will argue the case on Monday, February 6th as notified by the Clerk.

Very truly yours,

IDA O. CRESKOFF
Clerk

SW

LE COPY

Office-Supreme Court, U.S.
FILED
FEB 1 1961
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1960.

No. 611.

ALLEN B. DUMONT LABORATORIES, INC.,
Petitioner,

v.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Third Circuit.

STATEMENT FOR RESPONDENT IN OPPOSITION.

THOMAS COOCH,
120 Montvale Road,
Weston 93, Massachusetts,

ROBERT H. RINES,
No. 10 Post Office Square,
Boston 9, Massachusetts,
Counsel for Respondent.

January 27, 1961.

International, 711 So. 50th St., Phila. 43, Pa.

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1960.

No. 611.

ALLEN B. DUMONT LABORATORIES, INC.,
Petitioner,

v.

HELEN RUSSELL PIERCE, EXECUTRIX OF THE LAST WILL AND TESTAMENT OF GEORGE WASHINGTON PIERCE, DECEASED,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

STATEMENT FOR RESPONDENT IN OPPOSITION.

Respondent opposes grant of the pending petition for certiorari in this case on the basis that the decision sought to be reviewed is not final; not only because no order has been entered by the Court of Appeals, but also because the Court of Appeals still has before it for decision the merits of the patent issues involved. No time or expense would be saved by this Court's consideration of the matter prior to decision on the merits by the Court of Appeals, particularly in view of the denial on January 4, 1961 of petitioner's motion for a stay addressed to Mr. Justice Brennan.

Respectfully submitted,

THOMAS COOCH,
120 Montvale Road,
Weston 93, Massachusetts,

ROBERT H. RINES,
No. 10 Post Office Square,
Boston 9, Massachusetts,

January 27, 1961.